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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,976	04/26/2001	Erin H. Sibley	PD-200352A	1644

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EXAMINER	
USTARIS, JOSEPH G	

ART UNIT	PAPER NUMBER
2616	

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/844,976	SIBLEY, ERIN H.	
	Examiner	Art Unit	
	Joseph G. Ustaris	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) *13-17* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4/26/01*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-12, drawn to distribution of electronic content via satellite means, classified in class 725, subclass 67.

II. Claims 13-17, drawn to distribution of electric content that is compressed, classified in class 725, subclass 114.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable.

In the instant case, invention group I has separate utility such as distributing other types of information via satellite.

Furthermore, invention group II has separate utility such as compressing data for distribution over various computer networks. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

During a telephone conversation with Georgann Grunebach on 04 May 2005 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-12. Affirmation of this election must be made by applicant in replying to this

Office action. Claims 13-17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Information Disclosure Statement

2. The information disclosure statement (IDS) was submitted on 26 April 2001. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 09/844,923. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claim 1 in the instant application corresponds to claim 1 in application 09/844,923, since claim 1 in the instant application is broader than claim 1 in application 09/844,923, it would have been obvious to modify application 09/844,923 to get claim 1 in the instant application.

Allowance of claim 1 would result in the unwarranted time-use extension of the monopoly that would be granted for the invention as defined in claim 1 in application 09/844,923 if issued.

Claim 2 in the instant application corresponds to claim 2 in application 09/844,923.

Claim 3 in the instant application corresponds to claim 3 in application 09/844,923.

Claim 4 in the instant application corresponds to claim 4 in application 09/844,923.

Claim 5 in the instant application corresponds to claim 5 in application 09/844,923.

Claim 6 in the instant application corresponds to claim 6 in application 09/844,923.

Claim 7 in the instant application corresponds to claim 7 in application 09/844,923.

Claim 8 in the instant application corresponds to claim 8 in application 09/844,923.

Claim 9 in the instant application corresponds to claim 9 in application 09/844,923 with the limitation of "over-the-air broadcasting the electronic content packages during a vertical blanking interval of an analog television broadcast signal". It would have been obvious to modify claim 9 in application 09/844,923 to include this feature in order to increase the compatibility of the system to work with other older systems that are already established in the market.

Claim 10 in the instant application corresponds to claim 10 in application 09/844,923.

Claim 11 in the instant application corresponds to claim 11 in application 09/844,923.

Claim 12 in the instant application corresponds to claim 12 in application 09/844,923.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-7 and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks et al. (US006160989A) in view of Kim (US006556248B1).

Regarding claim 1, Hendricks et al. (Hendricks) discloses a "system of distributing electronic content" over various transmission media, e.g. CATV system (See Fig. 1). The system includes a "satellite" (See Fig. 1), "a network operations center uplinking electronic content to said satellite" (See Fig. 1, 202), "an over-the-air digital broadcast center receiving said electronic content from said satellite" (See Fig. 1, 208; column 7 lines 11-34), and a "user appliance receiving said electronic content" (See Fig. 1, 220). Furthermore, after receiving the "electronic content", the system "generates digital over-the-air electronic content" in order to successfully deliver the digital content to the user's site (See Fig. 3; column 7 lines 35-65 and column 10 lines 1-51). However, Hendricks, after receiving the "electronic content", does not disclose using the "vertical blanking interval (VBI)" to deliver the "digital over-the-air electronic content".

Hendricks discloses that analog signals are used between the headend and user terminals (See Fig. 3). Kim discloses a general TV broadcast system and TV receiving apparatus. The system is able to load HTML image and audio data or "digital electronic

content" within the VBI or "during a VBI of an analog broadcast signal" (See Figs. 1 and 3; column 5 lines 28-53). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the cable headend disclosed by Hendricks to be able to transmit some of the data or "electronic content" within the VBI of an "analog broadcast signal", as taught by Kim, in order to efficiently use the bandwidth available between the headend and user terminals thereby increasing the efficiency of the overall system.

Regarding claim 2, as disclosed in claim 1 rejection, Hendricks discloses a satellite (stratospheric platform) communicates (coupled) with the cable headend (over the air broadcast center).

Regarding claim 3, Hendricks discloses that one of the transmission media can be a cellular network (See Hendricks column 7 lines 29-34), which inherently includes a "cell tower".

Regarding claim 4, Hendricks in view of Kim discloses different types of transmission media (e.g. cellular networks) to the home and suggests that similar technology can be used interchangeably (column 7, lines 29-34). However, Hendricks does not explicitly disclose a TV broadcast tower.

Official Notice is taken that it is well known in the art that TV broadcast towers are used as a transmission scheme. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the system disclosed by Hendricks in view of Kim to include a TV broadcast tower in order to

provide more versatility, options of transmission, and robustness of transmission in case of malfunction by one scheme.

Regarding claims 5 and 6, Hendricks discloses both digital audio and video (See column 5 lines 6-16).

Regarding claim 7, the set top terminals or "user appliance" is "fixed" (See Hendricks Fig. 1).

Claim 9 contains the limitations of claim 1 (wherein the system performs the method) and is analyzed as previously discussed with respect to that claim.

Claim 10 contains the limitations of claims 2 and 9 and is analyzed as previously discussed with respect to those claims.

Claim 11 contains the limitations of claims 3 and 9 and is analyzed as previously discussed with respect to those claims.

Claim 12 contains the limitations of claims 4 and 9 and is analyzed as previously discussed with respect to those claims.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks et al. (US006160989A) in view of Kim (US006556248B1) as applied to claims 1-7 and 9-12 above, and further in view of Owa et al. (US006711379B1).

Hendricks in view of Kim does not disclose that the "user appliance is mobile".

Owa et al. (Owa) discloses a digital broadcasting system and terminal. Owa discloses mobile receiving terminals that can receive broadcasts from various sources (See Figs. 1, 23, and 24; column 7 lines 21-35). Therefore, it would have been obvious

to one with ordinary skill in the art at the time the invention was made to modify the system disclosed by Hendricks in view of Kim to include mobile receiving terminals or "mobile user appliance", as taught by Owa, in order to expand the capabilities of the system thereby making the system more convenient for the user by enabling the user to roam freely with the mobile terminal.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please take note of McCoy et al. (US006526575B1) for their similar methods of distribution of contents.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph G. Ustaris whose telephone number is 571-272-7383. The examiner can normally be reached on M-F 7:30-5PM; Alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on 571-272-7950 The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JGU
May 4, 2005

VIVEK SRIVASTAVA
PRIMARY EXAMINER